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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,583

05/17/2005

Gunter Langen

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4302

3000

7590

12/12/2006

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/532,583	<b>Applicant(s)</b> LANGEN ET AL.	
	<b>Examiner</b> Margaret G. Moore	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16 to 30 is/are pending in the application.  
4a) Of the above claim(s) 16 to 18, 23 to 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 to 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                       |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

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1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 16 to 18, drawn to an anti-adhesive layer, classified in class 106, subclass 287.14.
- II. Claims 19 to 22, drawn to a composite, classified in class 428, subclass 447.
- III. Claim 23, drawn to a method, classified in class 528, subclass 39.
- IV. Claims 24 to 29, drawn to a method of making a coating, classified in class 427, subclass 387.

2. The inventions listed as Groups I to IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. In the instant application, the claims in Group II lack novelty and/or inventive step over the prior. As such there cannot be considered to be a special technical feature in these claims.

Please note that Group I and Group II are related in an intermediate-final product relationship in which "for a wound dressing" in claim 16 indicates a future intended use of the layer claimed therein. Groups I and III are related in a product and process of making relationship in which the product can be made by another method such as mixing an organosilicon compound with silica prepared by a different manner, such as a silica that has been prepared and obtained commercially. Groups II and IV are related in a product and process of making in which the product can be made by mixing the hydrophobic organic silicon compound with a preformed silica, or by applying a silica

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nanosol first, followed by applying an organic silicon compound, followed by solvent removal.

3. During a telephone conversation with David Tener on 12/8/06 a provisional election was made with traverse to prosecute the invention of Group II, claims 19 to 22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16 to 18 and 23 to 29 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. To clarify, the Examiner notes that the epoxysilane in claim 21 is only required when the composite in claim 19 contains an anti-adhesive layer.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 19 to 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Thunhorst et al.

Thunhorst et al. teach foam compositions that contain functionalized metal oxide

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nanoparticles. As can be seen from patentees' claim 8, these can be used as wound dressings. Column 11, line 15, starts the teaching of silica nanoparticles. Column 12 teaches the addition of a hydrophobic silicon compound. Particular attention is drawn to Example 1. This prepares a composition containing a sol of silica nanoparticles and two silanes, including isooctyl trimethoxy silane which falls within the breadth of claim 20. Thus the coating composition prepared in Example 1 contains both a nanosol of silica and a hydrophobic organic silicon compound. This meets the requirement of the coating composition in claim 19. Again, since the composition in Thunhorst et al. can be a wound dressing, this anticipates claims 19 and 20.

Please note that the polymerizable components in the foam of Thunhorst et al. are not excluded from the instant claims.

For claim 21, note that the epoxysilane is not necessary for the coating composition containing a nanosol. On the other hand note that column 12, lines 8 to 10, teach epoxysilanes.

For claim 22, see column 6, lines 30 to 40. This teaches applying the composition onto a material such as a woven or non-woven material. This meets the claimed flat textile form.

8. Do et al. is cited as being of general interest. This reference teaches silica that is surface treated with silanes. It does not appear to be any closer to the claims than the reference cited supra. A rejection over this reference was not made in an effort to avoid redundancy.

9. The Examiner notes that she has requested English language translations of DE 100 15 600 and DE 100 54 119, cited in applicants' IDS and in the PCT search report. These translations were not available at the time this office action was made.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

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272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Margaret B. Moore  
Primary Examiner  
Art Unit 1712

mgm  
12/9/06